

REMARKS

Claims 1-9, 11-23, 25-36 and 38-73 are pending in the present application. Reconsideration of the present application is respectfully requested in view of the arguments set forth herein.

§ 112 REJECTIONS

In the Office Action, claims 15, 18-31 and 29 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Applicants respectfully disagree with these rejections.

As to claims 15 and 29, Applicants respectfully disagree with the Examiner's contention that the terms "upwardly" and "downwardly" are indefinite when read in light of the specification and the entirety of the respective claims. More specifically, the specification states:

"When it is desired to actuate the connector 10 from the locked to the unlocked position, hydraulic fluid is introduced into the primary releasing piston chamber 76 via the flow passage 78 in the outer body portion 7. As the chamber 76 becomes pressurized, the primary piston 1 and the lock mandrel 3 are forced upward. As the locking mandrel 3 moves upward relative to the locking segments 8, the ID protrusions 84, 82 and 80 on the locking mandrel 3 disengage from the OD protrusions 45, 47 and 49, respectively, on the locking segments 8. As the locking mandrel 3 is raised further, the upwardly facing tapered surface 86a on the protrusion or tooth 86 on the locking mandrel 3 engages the downwardly facing tapered surface 64a on the tooth 64 on the locking segments 8. The teeth 86 and 64 cooperate to cam the locking segments 8 radially outward and away from the first and second components 40, 30. As the locking segments 8 move outward, the central OD protrusion 47 on the locking segments 8 is received in the lower ID recess 37 on the locking mandrel 3. Similarly, the upper OD protrusion 45 is received in the upper ID recess 35. The upper end of the locking mandrel 3, including the upper ID protrusion 84, is received in a recess 90 in the upper body portion 9. Proper actuation of the primary piston 1 can be confirmed by observing the position of the indicator rod 12." (Specification, p. 10, ll. 6-21; emphasis added.)

The inclined surfaces referenced in claims 15 and 19 – 64a and 68a – are clearly shown in the drawings. See, *e.g.*, Figures 2a-2b. Thus, the use of the words “upwardly facing” and “downwardly facing” are used in their normal sense, *i.e.*, up or down relative to the ground. Such language is well understood in the art. In fact, the prior art reference the Examiner relies upon to reject the pending claims employs virtually identical language:

“In other words, the generally upwardly facing surfaces 32a on the saw tooth formations of dogs 26 and the generally downwardly facing surfaces 30a on the grooves of the wellhead have been brought into opposition with each other whereby they may serve as latching surfaces to prevent upward movement of the wellhead connector from the wellhead.” (Nelson, Col. 5, ll. 27-34; emphasis added.)

In view of the foregoing, it is respectfully submitted that “upwardly facing” and “downwardly facing” are terms that are not indefinite to those skilled in the art. Withdrawal of the rejection as to claims 15 and 29 is respectfully requested. Additionally, it should be noted that this same language is found in claims 43 and 55 which were not rejected by the Examiner, perhaps due to oversight.

As to claim 18, the § 112 rejection is simply not understood. For example, claim 1 contains very similar language to that in claim 18, yet claim 1 was not rejected under § 112. Applicants respectfully request clarification from the Examiner as to the specific reason why claim 18 was rejected under § 112. Applicants will be happy to address the § 112 rejection once it is properly understood. Absent more specificity from the Examiner, Applicants respectfully request that the § 112 rejection of claim 18 be withdrawn.

PRIOR ART REJECTIONS

In the Office Action, claims 1-99 [sic: 1-9, 11-23, 25-36 and 38-73] were rejected under 35 U.S.C. § 102 as allegedly being anticipated by Nelson (U.S. Patent No. 4,526,406). Applicants respectfully traverse the Examiner’s rejections.

As the Examiner well knows, an anticipating reference by definition must disclose every limitation of the rejected claim in the same relationship to one another as set forth in the claim. *In re Bond*, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). To the extent the Examiner relies on principles of inherency in making the anticipation rejections in the Office Action, inherency requires that the asserted proposition necessarily flow from the disclosure. *In re Oelrich*, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981); *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1463-64 (Bd. Pat. App. & Int. 1990); *Ex parte Skinner*, 2 U.S.P.Q.2d 1788, 1789 (Bd. Pat. App. & Int. 1987); *In re King*, 231 U.S.P.Q. 136, 138 (Fed. Cir. 1986). It is not enough that a reference could have, should have, or would have been used as the claimed invention. “The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *Oelrich*, at 326, quoting *Hansgirk v. Kemmer*, 40 U.S.P.Q. 665, 667 (C.C.P.A. 1939); *In re Rijckaert*, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993), quoting *Oelrich*, at 326; see also *Skinner*, at 1789. “Inherency ... may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *Skinner*, at 1789, citing *Oelrich*. Where anticipation is found through inherency, the Office’s burden of establishing prima facie anticipation includes the burden of providing “...some evidence or scientific reasoning to establish the reasonableness of the examiner’s belief that the functional limitation is an inherent characteristic of the prior art.” *Skinner* at 1789.

In a previous response prior to filing an appeal in this case, Applicants specifically noted that the Examiner did not specifically identify the “first component” and “second component” in Cuiper, the Examiner’s primary reference at that time. Response to Office Action Dated February 27, 2007, p. 3, ¶¶3-4. In the Final Office Action dated September 6, 2007, the Examiner again did not specifically identify what structure the Examiner contends is the “first component” and “second component” in Cuiper. Rather, the Examiner merely recited that the

first and second components are not part of the claimed invention. Final Office Action, p. 3. This shortcoming was specifically noted in Applicants' recent Appeal Brief. Appeal Brief, pp. 9-10.

The Examiner is correct that the "first" and "second" components are not part of the claimed invention, but it is legal error to ignore the express claim language that requires the claimed connector be adapted to engage the first and second components, as recited in the claims. That is, it is believed that to properly reject the pending claims, the Examiner must identify a connector that meets the limitations set forth in the claims. It appears that in the present Office Action the Examiner continues to ignore these express limitations because the Examiner has not specifically identified the "first" and "second" components set forth in the claims. Specifically, the Examiner states that the first and second component may have "any convenient size and shape." Office Action, p. 4.

As noted in Applicants' previous Appeal Brief, the use of "adapted to" language was specifically approved by the Board of Patent Appeals and Interferences in an appeal taken in the application that resulted in U.S. Patent No. 6,666,754. In the appeal of that case, the Board of Patent Appeals and Interferences did not sustain the Examiner's rejection under 35 U.S.C. § 112 for the use of the terminology "adapted to" in the claims at issue in that case. Decision on Appeal dated April 25, 2003. More specifically, in that case, the Examiner's rationale for the Section 112 rejection was as follows:

"The use of the terminology 'adapted to' makes the claim vague and indefinite because the scope of the claims cannot be ascertained, since it has been held the recitation that an element is 'adapted to' perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 U.S.P.Q. 138.

Decision on Appeal, p. 4. In reversing the Examiner's claim rejections under 35 U.S.C. § 112, the Board noted:

“The use of the terminology ‘adapted to’ in claim 21 does not render claims 21-32 vague and indefinite since the scope of the claim can be ascertained. As set forth by the Examiner, the recitation that an element is ‘adapted to’ perform a function is a limitation which requires only that the structure be able to perform the function. As such, the scope of the claims can be ascertained with a reasonable degree of precision and predictability.

Decision on Appeal, pp. 4-5. The use of “adapted to” language is also supported by the statements of the Board of Patent Appeals and Interferences in *Ex Parte Robert-A. Ollar*, 1994 WL 1687107, Bd. Pat. App. & Interf., 1994, which states:

“On the other hand, we are aware of support for a holding that ‘adapted to’ and ‘whereby’ clauses in claims further limit the claimed subject matter and should not be disregarded. For example, see *In re Venezia*, 530 F.2d 956, 958-59, 189 U.S.P.Q. 149, 151-52 (CCPA 1976). *Pac-Tec Inc. v. Amerace Corp.*, 903 F.2d 796, 801, 14 U.S.P.Q.2d 1871, 1876 (Fed. Cir. 1990) recognizes (emphasis added) that: ... by deleting the preamble and all limitations that include ‘adapted to,’ ‘whereby,’ and ‘thereby’ ... the claims are reduced to mere collections of parts.”

In view of the foregoing, it is respectfully submitted that the use of the “adapted to” language in the presently pending claims is proper. The scope of the claims containing the limitation is readily understandable. Thus, the limitation associated with such language must be considered a positively recited limitation. With this understanding, it is respectfully submitted that the pending claims are allowable.

Nelson is very far afield from the inventions set forth in the pending claims. Among other things, claim 1 recites that each of the locking segments has a first primary locking shoulder that is adapted to engage the first component and a second primary locking shoulder that is adapted to engage the second component. This basic structure is simply not present in Nelson. As understood by the undersigned, the latch dogs 26 in Nelson only engage the wellhead 10. It appears that the latch dogs 26 in Nelson could never engage a second component given the structure of the connector in Nelson, *i.e.*, the latch dogs 26 do not extend above the uppermost surface of the wellhead 10. In any event, it is clear that each of the latch dogs 26

(identified by the Examiner) in Nelson do not have locking shoulders that are **adapted to engage BOTH** the first and second components as recited in the claims. For at least this reason, the Examiner's anticipation rejection of all pending claims should be withdrawn. The above arguments apply equally with respect to all pending independent claims.

Additional comments are warranted with respect to the rejection of various dependent claims.

For example, dependent claim 3 recites that all of the engagement surfaces are substantially flat surfaces. However, the engagement surfaces 68/84 in Nelson are expressly described as inclined surfaces. Nelson, Col. 6, ll. 15-22. Thus, the rejection of claim 3 is clearly improper. In rejecting dependent claim 4, the Examiner expressly recognizes that engagement area 84 is a "tapered engagement area." Office Action, p. 6 (emphasis added). In rejecting claim 5, the Examiner contends that all of the engagement surfaces in Nelson are tapered surfaces. Office Action, p. 6. Yet, in rejecting claim 3, the Examiner contends that all of the engagement surfaces in Nelson are flat engagement surfaces. Simply put, the Examiner cannot have it both ways – the surfaces are either flat or tapered – they are not both.

With respect to dependent claim 6, the Examiner contends that Nelson discloses a connector that is threadingly coupled to a first component. Applicants respectfully disagree. Since the Examiner did not specifically identify what structure in Nelson he was referring to, it is difficult to address the rejection. Nevertheless, it appears that the only possible threaded connection in Nelson that could even be considered to meet this limitation would be the threaded connection between the cage 20 and the inner wall 16 of the connector 12. Nelson, Col. 1, ll. 38-68. Such a rejection is believed to be improper for several reasons. First, the cage 20 is an internal part of the overall connector 12. Second, the cage 20 is not adapted to engage a "first component" – the cage 20 engages the connector itself. Third, if the cage 20 is considered to be

the “connector” – which is contrary to the express disclosure of Nelson – it clearly does not meet the other limitations set forth in independent claim 1.

Additionally, dependent claim 11 further limits claim 1 by requiring that each of the locking segments have first and second secondary shoulders that area **adapted to engage** first and second secondary shoulders on the **first and second components**, respectively. Respectfully, there does not appear to be any structure in Nelson that could even be argued to be the secondary shoulders that are adapted to engage the structures recited in dependent claim 11.

The arguments set forth above with respect to the dependent claims apply equally to other dependent claims having the same limitations.

From the foregoing, it is respectfully submitted that there are many aspects of the pending claims that are clearly not present in Nelson. Accordingly, it is respectfully submitted that all pending claims are in condition for immediate allowance.

The Examiner is invited to contact the undersigned attorney at (713) 934-4055 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

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